



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,849	09/22/2000	Robert M. Berton	426882000400	2900

35452 7590 06/30/2004

ACCENTURE C/O MORRISON & FOERSTER  
755 PAGE MILL ROAD  
PALO ALTO, CA 94304

EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/668,849

Applicant(s)

BERTON ET AL.

Examiner

Rob Rhode

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 6, 9 - 11 and 21 - 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6, 9 - 11 and 21 - 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant amendment of 4-28-04 amended the specification, amended claims 1, 6 and 21 - 23 and added new claims 24 - 29 as well as canceled claims 2, 5, 7 - 8 and 12 - 20. In addition, applicant traversed rejections of Claims 1 - 23.

Currently, claims 1, 3, 4, 6, 9 - 11 and 21 - 29 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 6, 9, 10, 21, 22 - 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 1, the phrase "reserve fund" is a relative phrase, which renders the claims indefinite. The word "reserve fund" is not defined by the claim(s), the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For examination purposes, the phrase "reserve fund" will be defined as an escrow, whereby money from fees charged to users and/or vendors as well additional committed government development funds are held until conditions of the contract are met.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claim 1, 3, 6, 9 – 11 and 21 - 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over “NIC Launches Industry’s First Comprehensive Suite of eGovernment Solutions For Citizens, Business and Government”; PR Newswire; New York; June 1, 2000 (hereafter referred to as NIC I) and NICUSA web pages captured via the WayBack Machine (hereafter referred to as NIC II) and RFP # 194:0-12 RPB (hereafter referred to as “RFP”).**

Regarding Claim 1 (Currently Amended) and related claims 9 and 10, NIC I and II teaches a computer related method and system for funding a state government procurement system comprising the acts of:

- a. providing an Internet-based procurement system by a services provider for use by a state government agency for procurement of goods and services (see at least NIC I, Page 1 and NIC II, Page 2, Para 3);
- b. providing an Internet portal for use by the state government agency to communicate electronically with the Internet-based procurement system see at least NIC I, Page 1 and NIC II Page 2, Para 3);

Art Unit: 3625

c, providing an Internet portal for use by a qualified vendor wishing to sell goods and/or services to the state government agency (see at least NIC I, Page 1 and NIC II, Page 2, Para 3).

Even though it is implicit in the NIC II (Page 4, Para 5), the reference does not specifically disclose and teach a computer related method and system for funding a state government procurement system comprising the acts of:

d. determining payment funds from the state government agency for goods and/or services provided by the vendor (see at least Page 41, Para 4.2.31);

e. sending a first portion of the payment funds to the vendor (see at least Page 41, Para 4.2.31 and Page 41, b – Part II);

f. sending a second portion of the payment funds to a reserve fund (see at least Page 41, Para 4.2.31 and Page 41, b – Part II); and

g sending a provider payment from the reserve fund to the services provider (see at least (see at least Page 50, c). Please note that RFP does not specifically disclose a "reserve fund". However, RFP does disclose payments to the service provider after payment of vendors and it is well known in government contracting that funds are available (reserve fund) in order to legally release an RFP to industry – unless otherwise noted. Moreover and as taught by RFP, these funds are reserved in order to ensure payment of all parties associated with the contract (Page 41, Para 4.2.32 and Page 42, Para b – Part II). In that regard, one of ordinary skill in the art would have been motivated to extend RFP with a "reserve fund". In this manner, the contracting

Art Unit: 3625

State Agency would have the funds identified to pay the service provider based on submitted invoices from a reserve fund as well as determine and provide payments to associated vendors.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of NIC with the method and system of RFP to have enabled a computer related method for funding a state government

Procurement system comprising the acts of: a. providing an Internet-based procurement system by a services provider for use by a state government agency for procurement of goods and services; b. providing an Internet portal for use by the state government agency to communicate electronically with the Internet-based procurement system; c. providing an Internet portal for use by a qualified vendor wishing to sell goods and/or services to the state government agency; d. determining payment funds from the state government agency for goods and/or services provided by the vendor; e. sending a first portion of the payment funds to the vendor; f. sending a second portion of the payment funds to a reserve fund; and g. sending a provider payment from the reserve fund to the services provider – in order to provide a procurement system, which is payed for through user fees and ensures that the service provider implementing the site is payed. NIC discloses state eprocurement method and systems for an internet portal for use by state agencies and vendors (Page 1 and Page 2, Para 3). RFP discloses an eprocurement portal, which provided determining payment of vendors as well as a service provider (Page 1 and Page 41, Para 4.2.31 and Page 41, b – Part II). Therefore,

it would have been obvious to one of ordinary skill in the art at the time of the invention to have extended NIC with a method and system for d. determining payment funds from the state government agency for goods and/or services provided by the vendor; e. sending a first portion of the payment funds to the vendor; f. sending a second portion of the payment funds to a reserve fund; and g. sending a provider payment from the reserve fund to the services provider. In that regard and with this incentive plan, the state agency and service provider will benefit from cost savings as well as potential additional sales through the eprocurement portal. Thereby, the users satisfaction will be increased, which will increase the potential use of the portal and the commensurate enumeration benefits for all.

Regarding Claim 3 (Previously Presented), NIC II teaches a method comprising an additional act of providing an Internet portal for a customer of the state government agency, whereby the customer can execute an electronic transaction, via the Internet-based procurement system, with the state government agency in exchange for a fee, wherein the customer is one of the group consisting of a person seeking a driver's license, a person seeking a vehicle license, a person seeking a voter registration, a person seeking a license to practice professionally in the state, a person seeking a business registration, a person seeking a sales tax certificate, a person seeking a sales permit and a person seeking a generic state identification document (see at least Page 3, Para 4).

Art Unit: 3625

Claim 6 and related claims 26 and 29 (Currently Amended), RFP teaches a method, further comprising: when an input into the reserve fund exceeds an excess-funding threshold, sending a first portion of a corresponding surplus from the reserve fund to the services provider and sending a second portion of the corresponding surplus to the state government agency; and when an input into the reserve fund falls below an insufficient-funding threshold, carrying out an insufficient-funding revision including at least one of: reducing the first portion of the payment funds that are sent to the vendor and increasing the second portion of the payment funds that are sent to the reserve fund, reducing a scope of service of the internet-based procurement system, and sending a supplemental payment from the state government agency to the reserve Fund (see at least Page 42 and Page 51, Para 9.5 and 9.7). Please note that RFP does not specifically disclose when an input into the reserve fund exceeds an excess-funding threshold, sending a first portion of a corresponding surplus from the reserve fund to the services provider and sending a second portion of the corresponding surplus to the state government agency; and when an input into the reserve fund falls below an insufficient-funding threshold. However, these types of contract incentive programs/plans - in the commercial sector as well as the government contracting sector were old and well known at the time of the invention. Therefore, it would have been obvious to one of ordinary skill in the art to have extend RFP with an input into the reserve fund exceeds an excess-funding threshold, sending a first portion of a corresponding surplus from the reserve fund to the services provider and sending a second portion of the corresponding surplus to the state government agency; and when



an input into the reserve fund falls below an insufficient-funding threshold, carrying out an insufficient-funding revision. Thereby, the incentive plan is established to increase the probability that agency and service provider metrics are more closely aligned, which will increase the probability of success of the eprocurement portal.

Regarding Claim 11 (Previously Presented), NIC teaches a system wherein the computerized eProcurement system for a state government agency is provided by a services provider for use by the state government agency for procurement of goods and services, where the computerized eProcurement system is funded by fees comprising payments from participating vendors, payments by investment from the services provider, and payments by transaction fees collected from customers comprising persons seeking services from a state agency through use of the computerized eProcurement system (see at least NIC 1 – Page 4, Para 6, Page 5, Para 1 – 5 and NIC 2, Pages 1 and 2).

Regarding Claim 21 (Currently Amended), RFP teaches a method, further comprising: sending a development payment from the reserve fund to the services provider for funding development of the Internet-based procurement system (see at least Page 42).

Regarding Claim 22 (Currently Amended) and related claims 24 and 27 (New), RFP teaches a method, further comprising: when an input into the reserve fund exceeds an excess-funding threshold, sending a first portion of a corresponding surplus from the

Art Unit: 3625

reserve fund to the services provider and sending a second portion of the corresponding surplus to the state government agency (see at least Page 42).

Claim 23 (Currently Amended) and related claims 25 and 28 (New), RFP teaches a method, further comprising: when an input into the reserve fund falls below an insufficient-funding threshold, carrying out an insufficient-funding revision including at least one of: reducing the first portion of the payment funds that are sent to the vendor and increasing the second portion of the payment funds that are sent to the reserve fund, reducing a scope of service of the Internet-based procurement system, and sending a supplemental payment from the state government agency to the reserve Fund (Page 51, Para 9.5 and 9.7).

**Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of NIC I and II and RFP as applied to claim 1 above, and further in view of "Auctions Pay Dividends for Gov't"; L.S. Tillet; News release; May 2000, [www.internetwk.com](http://www.internetwk.com); 4pgs (hereafter referred to as "Auctions").**

The combination of NIC I and II and RFP substantially disclose and teach the applicant's invention.

However, the combination of NIC I and II and RFP does not specifically disclose and teach wherein the state government agency is able to use the internet-based

procurement system to sell by auction or other methods, obsolete or excess inventory held by the state government agency to interested buyers.

On the other hand and regarding claim 4, Auction teaches a method wherein the state government agency is able to use the internet-based procurement system to sell by auction or other methods, obsolete or excess inventory held by the state government agency to interested buyers (Page 3, Para 1 and 2).

It would have been obvious to one of ordinary skill in the art to have provided the combination of NIC I and II and RFP with the method of Auctions to have provided the capability to use the internet-based procurement system to sell by auction or other methods, obsolete or excess inventory held by the state government agency to interested buyers – and thereby increase the opportunity to reduce inventory cost, gain revenue and thus increase the possibility of decreased taxes, while clearly demonstrating the effectiveness of eGovernment initiatives to taxpayers.

### ***Response to Arguments***

Applicant's arguments, filed 4-28-2004, with respect to the rejection(s) of claim(s) 1 – 23 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a new reference - RFP.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is Gardner (US 5,758,327), which addresses online procurement/requisitions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeff Smith** can be reached on **(703) 308-3588**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

or faxed to:

**(703) 872-9306** [Official communications; including  
After Final communications labeled  
"Box AF"]

**(703) 746-7418** [Informal/Draft communications, labeled

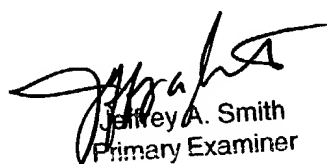
Application/Control Number: 09/668,849  
Art Unit: 3625

Page 12

"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RER



Jeffrey A. Smith  
Primary Examiner